



MAIL STOP AF  
RESPONSE UNDER 37 C.F.R. § 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 3714

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE


Application No. : 10/658,976  
Applicants : Alfred Thomas  
Filed : September 10, 2003  
Title : Method and Apparatus For Conducting A Video Poker Game

TC/A.U. : 3714  
Examiner : John M. Hotaling  
Docket No. : 247079-00227USPT  
Customer No. : 70243

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 24, 2007

Signature:   
Christine Pisarski

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

The Final Office Action was mailed on January 9, 2007 and an Advisory Action was mailed on April 24, 2007, and the shortened time period to respond is April 24, 2007. This Pre-Appeal Brief Request for Review is being filed on May 24, 2007, together with a Petition for Extension of Time and Notice of Appeal.

The primary reference is U.S. Publication No. 2004/0063483 ("Wolf") which generally relates to hold card strategies for a poker game. Wolf does not anticipate the elements of the pending claims and the Examiner has improperly stretched the bounds of vague and generalized statements in Wolf to attempt to patch together the claim elements.

**A. The Fundamental Difference Between Wolf's Strategic Analysis Tool To Obtain Winning Hands And Indicators To Assist Players To Identify Already Winning Hands As In The Present Claims**

The present claims relate to a video poker game which facilitates identification of a winning hand to a player. After dealing a plurality of playing cards into a hand, the method distinguishes the winning ones of the cards that yield the award-winning ranking from other ones

of the cards **if and only if** the dealt hand has one of the award-winning rankings. If the hand does not qualify for an award-winning ranking, no cards are distinguished. Thus, the present claims do not relate to strategy as there is no hold advice to allow a player to transform a non-winning hand to a winning hand. Obviously, strategic advice would designate cards to hold in a non-winning initial hand to create a better chance of obtaining a winning hand, but the present claims do not allow for this consideration because they are not directed toward strategy.

The present application therefore differs from auto-hold strategies that determine optimal cards to hold in potentially winning hands (i.e., currently non-winning hands). Wolf discloses such a strategic hold analysis tool which dispenses hold advice regardless of whether the hand is a winning hand. A gaming device 10 that incorporates an auto-hold strategy automatically determining the mathematically optimal or best cards 35 to hold for all possible hands. Wolf displays this suggestion 33 to the player and, in some embodiments, automatically holds these cards 35 for the player. The player may choose to hold the cards 35 selected by the gaming device 10 or select other or no cards 35 to hold. The player then presses the deal button 20 and the unwanted cards 35 are removed from the display 30 and the replacement cards 35 are dealt from the remaining cards in the deck. *See* Wolf, ¶033.

The approach in Wolf causes the problems of auto-hold strategies detailed in the specification, namely annoying certain players. As the specification explains “the auto-hold feature tends to annoy players. If a player disagrees with the automatically held cards, the player must unhold those cards and then hold the cards the player wishes to hold.” (Specification, ¶ 004).

**B. The Independent Claims Are Allowable Because Wolf Does Not Disclose Holding Cards From The Dealt Hand If And Only If the Dealt Hand Has One Of The Award Winning Rankings As Required By The Claims**

Claims 1, 11 and 21 include the element of distinguishing winning cards from the dealt hand if and only if the dealt hand has one of the award-winning rankings. There is no strategic analysis of a hand, the claims only determine whether the hand is an award winning hand.

Wolf does not disclose disclosing winning cards, if and only if the dealt hand is a winning hand. The Wolf disclosure repeatedly discusses selecting the mathematically optimal or strategically best cards 35 as hold cards. *See* Wolf, Abstract, ¶¶0005-8, 0010, 0028, 0031, 0033, 0036, 0039, 0042 and 0061. Because these are strategies rather than simply identifying winning

hands, the mathematically optimal or best cards 35 may or may not form an award-winning hand. *See* FIGS. 4a-b. In fact, there are countless hands where the mathematically optimal hands are selected even where an award-winning hand is not dealt. Wolf does not disclose limiting the automatic distinguishing of cards within a dealt hand only when the dealt hand has one of the award-winning rankings contained therein, as specifically required in the claims.

**C. The Final Office Action Improperly Imparts Undisclosed Elements From Wolf**

**1. The Present Claim Elements Cannot Be Anticipated By Wolf's Vague Recitation That Other Gaming Strategies May Be Used**

The Final Office Action and Advisory Action cannot point to any section of Wolf that discloses a hold element for only winning hands. The Final Office Action and Advisory Action assert that Wolf “makes it apparent that a number of gaming strategies can be programmed” and therefore the method in the claims could be one of the unknown gaming strategies. (pp. 6-7, Final Office Action, p. 2 Advisory Action). As will be explained in the above section, nothing in Wolf explicitly discloses “distinguishing winning cards from the dealt hand if and only if the dealt hand has one of the award-winning rankings.” The Examiner’s attempt to bring the explicit limitations of the claims under vague statements in Wolf fails to meet the strictures of 35 U.S.C. 102. It is only proper to cite references such as Wolf for what is explicitly disclosed. It is therefore improper to read the claim elements into vague phrases indicating that other strategies exist but where Wolf does not disclose the specific method in the pending claims.

**2. The Conservative Strategies In Wolf Cited By The Examiner Do Not Disclose Only Holding Cards in Winning Combinations**

The Final Office Action asserts that Wolf “explicitly teaches the distinguishing step occurring if the dealt hand includes one of the award winning ranking by teaching a variety of different auto-hold strategies, including a ‘conservative’ strategy that teaches auto-holding cards which are part of an existing winning combination.” (p. 2). However, even this “conservative” strategy is not limited to only distinguishing cards within a hand that contains an award-winning ranking as required by the claims. Under the “conservative” strategy, Wolf would still select the mathematically optimal hands for a player even if the player’s hand does not contain an award-winning ranking. (¶ 044).

### **3. The Different Hold Strategies In Wolf Do Not Anticipate the Present Claims Which Are Not A Strategy**

The Final Office Action continues by asserted that since Wolf discloses different auto-hold strategies, one strategy could be to define a hold strategy that only holds cards that are part of an award winning hand. (pp. 6-7). The Final Office Action has cited ¶¶ 010-11 and 044-62 of Wolf for this proposition. These paragraphs merely describe a method for putting together a table with potential dealt hands and hold instructions to maximize either the value or the chance of obtaining a winning hand to support a hold strategy. The sections cited do not disclose implementing a hold instruction for only winning hands. In fact, all of these tables assume a strategy of holding certain cards when the hand is not a winning hand. It is improper to cite such a vague section as there is no evidence that one of skill in the art reading Wolf could deduce that the present claims could be determined from this vague section.

The Final Office Action has asserted that Wolf discloses at least one scenario to keep all the cards and thus teaches toward a selective hold display since cards do not have to be designated as held each and every time the game is played. This proposition does not anticipate the claims which only hold cards if and only if hands are winning hands. Simply because certain strategies in Wolf may include holding winning hands does not imply that these strategies mandate that no cards will ever be held for non-winning hands. Such a technique would not be consistent with either maximizing hand value or the probability of obtaining a winning hand disclosed in Wolf because either the value of non-winning hands or the probability of obtaining a winning hand from a non-winning hand would always mandate holding certain cards in at least one non-winning hand.

### **4. Wolf Teaches Away From Holding Cards Only For Winning Hands**

The Final Office Action asserts that Wolf implicitly discloses the strategy of only showing holds for award winning hands. (Final Office Action, p. 7). Nowhere does Wolf disclose, teach, or suggest distinguishing winning ones of the cards in a dealt hand from other ones if and only if the dealt hand has one of the award-winning rankings, as in the claims. In fact, Wolf specifically teaches away from such an apparatus and method by explicitly and repeatedly reiterating that the gaming device 10 automatically determines which are the mathematically optimal or best cards 35 to hold. As every single dealt hand will have

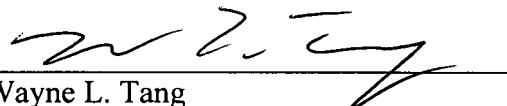
“mathematically optimal” cards 35 to hold, Wolf teaches away from distinguishing cards only if the hand has one of the award-winning rankings. Additionally, the overall purpose of Wolf is to display to a player the mathematically optimal or best way to play a game. *See* Wolf, Abstract. To read Wolf as applying hold indicators to solely award-winning hands, as the Final Office Action states, would undermine the purpose and teachings of Wolf as it would not maximize value of non-winning hands. There is simply no evidence in Wolf of such a motivation to include a “strategy” of never highlighting cards to be held for any and all non-winning hands. In fact, the other sections of Wolf teach away from any suggestion. Further, the sections of Wolf cited by the Examiner to formulate the so called strategies (auto-hold tables), actually indicate that a hold strategy will be created for each situation (i.e. including non-winning hands) (see e.g., ¶ 050 (“each game situation”) and ¶ 052 (applying every possible hold code for each possible outcome)).

**Conclusion**

It is the Applicants’ belief that all of the pending claims are in condition for allowance and that the Final Office Action and Advisory Action are in error in rejected the pending claims.

Respectfully submitted,

Date: May 24, 2007

  
\_\_\_\_\_  
Wayne L. Tang  
Reg. No. 36,028  
Nixon Peabody LLP  
161 N. Clark Street., 48<sup>th</sup> Floor  
Chicago, IL 60601-3213  
(312) 425-3900 (Tel)

Attorney for Applicants